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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,030	08/17/2000	Leanne M. Capozzi	81503F-P	4827

1333 7590 06/09/2006

PATENT LEGAL STAFF  
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ROCHESTER, NY 14650-2201

EXAMINER
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HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application N .</b>	<b>Applicant(s)</b>	
	09/641,030	CAPOZZI ET AL.	
	<b>Examin r</b>	<b>Art Unit</b>	
	Mark T. Henderson	3722	

-- The MAILING DATE of this c mmunication appears on the cover she t with the c rrespondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 and 53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED OFFICE ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1-23 and 53 have been amended for further examination. Claims 24-52 have been canceled.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

*Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4, and 53 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14-17 of copending Application No. 10/754,350, and Application No. 11/106,971. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications disclose a kit comprising a plurality of labels comprising machine readable code; a hard copy visually printed instruction form having machine readable code and separate label; an order form (index print for selecting fulfillment form a collection of digital images) having machine readable instructions (means for providing information in a "payment field").

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

In regards to **Claims 1**, wherein a kit is used for organizing a plurality of images provided by a customer on a plurality of hard copy prints; an order form configured to include at least one good and/or service selectable by a customer, and further to provide an order to be fulfilled by a service provider; a machine readable code configured to organize a plurality of customer provided hard copy images into categories and to forward the images to the service

provider to fulfill the order; a holder for organizing the images; pockets for organizing the images and for associating the instruction form with the plurality of hard prints; and a scanning device to provide meta-data regarding one or more subsequent images, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, order form, machine-readable coded bars containing codes and holder pockets of Nelson et al can be configured to include any goods or services and to provide an order; can be configured to organize a plurality of customer provided hard copy images into categories (in this case codes can be programmed to provide any information that the end user desires).

3. Claims 5-14, 16, and 21-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14-17 of copending Application No. 10/754,350 and 11/106,971 in view of Wentworth, Hicks, and further in view of Johnson et al.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications disclose a kit comprising a plurality of labels comprising machine readable code; a hard copy visually printed instruction form having machine readable code and separate label; an order form (index print for selecting fulfillment form a collection of

digital images) having machine readable instructions (means for providing information in a “payment field”).

However, McIntyre et al does not disclose: wherein the instruction are provided in an audio or visual format; a holder for organizing the images; holder includes pockets; holder comprises an envelope; instructions are associated with a unique order instruction

Wentworth discloses in Fig. 1, a kit for organizing comprising: an envelope holder (12) which can include pockets (Col. 3, lines 51-53); and a container (11) having other sections for holding other formats such as cards.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify McIntyre et al’s kit with an envelope holder and a container as taught by Wentworth for holding images and a container for holding additional items.

However, McIntyre et al as modified by Wentworth does not disclose: a kit for organizing images; an instruction form having a code capable of being machine read so as to obtain information for use in organizing; instructions on how to use the kit; a holder and pocket for organizing images; an instruction associated with a unique order instruction, and information associated with the images; a container for holding images; wherein the code comprises a color for the instruction form; wherein the instruction form is the same size as the hard copy prints; and a tool for use in determining the number of the image to be scanned.

Hicks discloses in Fig. 2, an order form (14) for ordering goods (26), wherein the order form can be read by a tool (computer data base and reading device, as stated in Col. 4, lines 5-26).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify McIntyre et al's kit to include an order form as taught by Hicks for the purpose of ordering items desired by the end user.

However, McIntyre et al as modified by Wentworth and Hicks does not disclose wherein the code comprises a color for the instruction form; and wherein the instruction form is the same size as the hard copy prints.

Johnson et al discloses in Fig. 1, a form which can comprise a machine readable code (26) to be read by a scanner, which can be in any form (shape, color, size, etc..) such as an icon (Col. 4, lines 62-64), and human readable indicia (12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify McIntyre et al's kit to include an instruction form having encoded indicia as taught by Johnson et al for the purpose of informing the end user.

In regards to **Claims 5, 6, 8, 9, 12-14 and 21**, wherein a kit is used for organizing a plurality of images provided by a customer on a plurality of hard copy prints; an order form configured to include at least one good and/or service selectable by a customer, and further to provide an order to be fulfilled by a service provider; a machine readable code configured to organize a plurality of customer provided hard copy images into categories and to forward the images to the service provider to fulfill the order; a holder for organizing the images; pockets for organizing the images and for associating the instruction form with the plurality of hard prints; and a scanning device to provide meta-data regarding one or more subsequent images; a recitation of the intended use of the claimed invention must result in a structural difference

between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the kit of Wentworth is configured to include any goods or services and to provide an order; can be configured to organize a plurality of customer provided hard copy images into categories (in this case codes can be programmed to provide any information that the end user desires).

In regards to **Claim 5 and 53**, the method of organizing obtained images by scanning does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious to complete the order form by any means.

In regards to **Claim 9 and 10**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desired instructional information, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus there is no novel and unobvious functional relationship between the printed matter and the substrate that is required for patentability.



In order for the printed matter (instructions) to impart patentability to the kit, there must be a new and non-obvious functional relationship between the printed matter and some element of the kit (substrate). Therefore, it would have been obvious to provide any desired instructional information, since applicant has not disclosed the functional relationship between the printed matter (instructions) and the substrate (Kit) to distinguish the instructions from the prior art of Wentworth

In regards to **Claim 23**, it would have been an obvious to construct the instruction form in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would be obvious to make the code of Wentworth in any size, since applicant has not disclosed the criticality of having an instructional form in a particular size, and further wherein the instructional form would function equally as well in any desired since it is only disclosing information.

This is a provisional obviousness-type double patenting rejection.

***Allowable Subject Matter***

Claims 15 and 17-20 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sailus et al, McIntyre et al ('989), Capozzi et al, Taylor, Yamaoto, Slater et al, Oka et al, Mont et al, Lumley, Fuhrer et al, Barad et al, Kraft, and Tai disclose similar kits.

***Response to Arguments***

Applicant's arguments with respect to claims 1-23 and 53 have been considered but are moot in view of the new ground(s) of rejection.

McIntyre et al ('971) and McIntyre et al ('350) are both used to disclose a kit for organizing images.

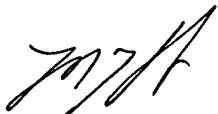
***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Monica Carter, can be reached at (571) 272-4475. The formal fax number for TC 3700 is (571) 273-8300.



MTH

June 5, 2006

  
MONICA CARTER  
SUPERVISORY PATENT EXAMINER